

## **REMARKS**

Claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 were pending and rejected in Final Office actions dated July 8, 2003 and March 2, 2004, after which this application proceeded to Appeal. The Board and Patent Appeals and Interferences rendered a decision on the Appeal dated January 26, 2009, affirming the Examiner's rejections of all claims. A Request for Continued Examination is submitted herewith, reopening prosecution under 37 C.F.R. § 1.114.

Claims 1-5, 7-10, 13-17, 19, 21-22, 24-26, 29, 31-33, 37-38, 40-41, 50, 53, 56, 59, 64-65, 67-68 and 129 are amended herein. Support for these amendments is found throughout the Specification, *e.g.*, at p. 25, ll. 8-26 and p. 26, ll. 16-21. No new matter is added. Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and withdraw them.

### **Response to Rejection under 35 U.S.C. § 103(a)**

In the Final Office Actions dated 7/8/2003 and 3/2/2004, claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman, U.S. Patent No. 5,960,411 in view of Yamada, U.S. Patent No. 6,336,100. Claim 8 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Hartman/Yamada in view of Official Notice. Claims 14 and 36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman/Yamada in view of Holland, U.S. Patent No. 6,493,742. These rejections are now traversed.

1. Hartman not available as § 103(a) art

Applicant respectfully submits that use of the Hartman reference is improper as the basis of this rejection under 35 U.S.C. § 103(a). Hartman was, "at the time the claimed

invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c).

In view of 35 U.S.C. § 103(c), Applicant respectfully submits that Hartman cannot preclude patentability of the claimed invention because per that section:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.** (Emphasis added.)

Hartman is available under 35 U.S.C. § 102(e) only. Hartman was assigned to Amazon.com, Inc. of California in an assignment recorded 6/22/1998 at reel 009264, frame 0284, attached as Exhibit A. The present application was assigned to the same Amazon.com, Inc., in an assignment recorded on 1/12/2001, at reel 011462, frame 0567. A copy of this assignment and recordation information therefore is attached as Exhibit B for Examiner’s reference. Hartman and the present application both currently remain under these assignments.

Thus, the subject matter of Hartman and the present application were, at the time the present application with the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Thus, under 35 U.S.C. § 103(c) the subject matter of Hartman cannot preclude patentability of the claimed invention. Therefore, it is respectfully submitted that this basis for the rejection of claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 is improper and should be withdrawn.

2. Substantive § 103(a) rejections

It is admitted in the Final Office Action that Hartman alone does not disclose the claim limitations recited in claims 2-8, 13-27, 30, 35-38, 51-55, 57-58, 60-63, 65, and 129. Rather Hartman is combined with Yamada and/or Holland.

Yamada and Holland, alone or in the suggested combinations, do not remedy the deficiencies caused by the unavailability of Hartman as prior art under 35 U.S.C. § 103(a), nor does the Examiner assert that they do. *I.e.*, Yamada and/or Holland, and/or Official Notice, alone or in the suggested combinations, do not disclose or suggest the limitations for which the Examiner proffers Hartman for claims 1, 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68. Thus, the deficient disclosures of these references fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. § 103(a) can be made, since each element of the claims is not disclosed or suggested by the references.

### **Conclusion**

In sum, Applicants respectfully submit that claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68, and 129 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,  
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